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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,202	09/29/2000	David Bar-Or	4172-3	3734

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EXAMINER

LUKTON, DAVID

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 01/14/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/678,202

Applicant(s)

BAR-OR ET AL.

Examiner

David Lukton

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 1-58,85,105,109,113,117,140,163,186-210,234,238,242,265,288-311,332 and 352.

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1-58,85,105,109,113,117,140,163,186-210,234,238,242,265,288-311,332 and 352.

Pursuant to preliminary amendment, the following claims have been cancelled: 59-84, 86-104, 106-108, 110-112, 114-116, 118-139, 141-162, 164-185, 211-233, 235-237, 239-241, 243-264, 266-287, 312-331, 333-351 and 353-374. In addition, several claims have been amended to reflect a change in claim dependence.

Claims 1-58, 85, 105, 109, 113, 117, 140, 163, 186-210, 234, 238, 242, 265, 288-311, 332, and 352 are now pending.

*

A restriction is imposed, as set forth below. First, however, the following subgenera are defined:

G1: Within this subgenus, the structure of the compound cannot be determined without consulting a document which has been "incorporated by reference". In the case of claim 1, this subgenus would include a peptide consisting of a specific amino acid sequence which falls within the scope of claim 1, and which sequence is disclosed in a document which has been "incorporated by reference", but which sequence is not disclosed anywhere in the instant specification. Subgenus G2 is excluded from subgenus G1;

G2: The compounds to which the claims are drawn are limited to those for which the structures are apparent without consulting a document which has been "incorporated by reference";

G3: within this subgenus, variable P1 must be substituted in accordance with the mandates of claim 206 or 307;

G4: within this subgenus, variable P2 must be substituted in accordance with the mandates of claim 208 or 309;

G5: This subgenus is limited to the compounds that are encompassed by claims 185-209.

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Restriction to one of the following inventions is required under 35 U.S.C. §121:

1. Claims 1-58, drawn to a method of reducing the damage done by “ROS” in an animal, wherein the compounds are limited to G1.
2. Claims 1-58, drawn to a method of reducing the damage done by “ROS” in an animal, wherein the compounds are limited to G2.
3. Claim 85, drawn to a method of reducing the concentration of metal ions in an animal, wherein the compounds are limited to G1.
4. Claim 85, drawn to a method of reducing the concentration of metal ions in an animal, wherein the compounds are limited to G2.
5. Claim 109, drawn to a method of reducing the damage done by “ROS” in a tissue that has been removed from an animal, wherein the compounds are limited to G1.
6. Claim 109, drawn to a method of reducing the damage done by “ROS” in a tissue that has been removed from an animal, wherein the compounds are limited to G2.
7. Claim 113, drawn to a method of reducing the concentration of metal ions in an animal, wherein the compounds are limited to G1.
8. Claim 113, drawn to a method of reducing the concentration of metal ions in an animal,

wherein the compounds are limited to G2.

9. Claim 117, drawn to a method of reducing the damage done by “ROS” in an animal, wherein the compounds are limited to G1.

10. Claim 117, drawn to a method of reducing the damage done by “ROS” in an animal, wherein the compounds are limited to G2.

11. Claim 140, drawn to a method of reducing the damage done by “ROS” in a tissue that has been removed from an animal, wherein the compounds are limited to G1.

12. Claim 140, drawn to a method of reducing the damage done by “ROS” in a tissue that has been removed from an animal, wherein the compounds are limited to G2.

13. Claim 163, drawn to a method of reducing the concentration of metal ions in an animal, wherein the compounds are limited to G1.

14. Claim 163, drawn to a method of reducing the concentration of metal ions in an animal, wherein the compounds are limited to G2.

15. Claims 186-205, drawn to peptides in which P1 is limited to Xaa₁-Xaa₂-His, and both G3 and G4 are excluded.

16. Claims 186-205, drawn to peptides in which P1 is limited to Xaa₁-Xaa₂-His-Xaa₃, and both G3 and G4 are excluded.

17. Claims 206-209, drawn to peptides in which P1 is limited to Xaa₁-Xaa₂-His

18. Claims 206-209, drawn to peptides in which P1 is limited to Xaa₁-Xaa₂-His-Xaa₃.

19. Claim 210, drawn to a kit.
20. Claim 234, limited to G1,
21. Claim 234, limited to G2, and with the further proviso that G5 is excluded.
22. Claim 238, drawn to a kit.
23. Claim 242, drawn to peptides, limited to G1.
24. Claim 242, drawn to peptides, limited to G2.
25. Claim 265, drawn to a kit.
26. Claims 288 - 306, drawn to peptides in which P1 is limited to Xaa₁-Xaa₂-His, and both G3 and G4 are excluded.
27. Claims 288 - 306, drawn to peptides in which P1 is limited to Xaa₁-Xaa₂-His-Xaa₃, and both G3 and G4 are excluded.
28. Claims 307-310, drawn to peptides in which P1 is limited to Xaa₁-Xaa₂-His.
29. Claims 307-310, drawn to peptides in which P1 is limited to Xaa₁-Xaa₂-His-Xaa₃.
30. Claim 311, drawn to peptides.
31. Claim 332, drawn to peptides.
32. Claim 352, drawn to peptides of the formula P₃-L-P₃, limited to G1.
33. Claim 352, drawn to peptides of the formula P₃-L-P₃, limited to G2.

The claimed inventions are distinct.

Subgenus "G1" and "G2" have been created. In the case of the method claims, applicants could "extract out" a genus of compounds from a document that has been referred to in the specification, and then argue that the compounds disclosed therein can be used, e.g., to reduce the damage done by "ROS", or reduce the concentration of metal ions in a mammal. Should applicants decide to pursue such a course of action, it is suggested that the specification be amended prior to the first Office action (on the merits) to incorporate the subject matter which is intended to be "extracted" from the references. Or in the case of e.g., claim 206, applicants could "extract out" a genus of chelators from documents such as those referred to on page 22, line 25+, and then create a new genus of compounds which could not have been envisioned from a reading of the specification. Should applicants decide to choose a group which does not include G1, the opportunity to extract out such information from references will have passed.

Inventions {26-33} and {1-14} are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). Nevertheless, in the event that any of Groups 26-33 is elected, and claims therein found allowable, the corresponding method-of-use claims will be rejoined for further examination provided that the limitations present in the claims (drawn to

compounds) are incorporated into the method claims [*In re Ochiai* (37 USPQ2d 1127)].

In addition, in the event that any of Groups 26-33 is elected, and claims therein found allowable, it would be appropriate to rejoin the corresponding composition claims and kit claims (with the same limitations on structures).

In addition to the foregoing, if the elected group proves to be novel in its present form, the possibility of rejoining one or more of the non-elected groups may be considered.

Applicant is advised that for the response to this requirement to be complete, an election of the invention to be examined must be indicated, even if the requirement is traversed (37 C.F.R. 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

. . . .

In addition to the foregoing, applicants are required under 35 U.S.C. §121 to elect a disclosed specie for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. A "specie" is a specific compound, with all substituent variables fully accounted for.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.




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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 703-308-3213. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at (703) 308-2923. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



DAVID LUKTON
PATENT EXAMINER
GROUP 1800